

REMARKS

Applicant requests reconsideration of this application in view of the following remarks and accompanying amendments. Claims 1, 2, 5-10, 13-20, 22-27, 29-36, 39-44, and 47-65 were pending. Applicant amends claims 1, 9, 17-19, 26, 33-35, 43, 51, 52, and 65 herein. As a result, claims 1, 2, 5-10, 13-20, 22-27, 29-36, 39-44, and 47-65 remain pending in the instant application.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 2, 5, 9-10, 13, 17-20, 22, 26-27, 29, 33-36, 39, 43-44, 47, and 51-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman et al. (U.S. 6,317,761) in view Shaw et al. (U.S. 2001/0005855) in further view of Heene et al. (U.S. 2004/0254853). Applicant respectfully traverses this rejection for at least the reason that the disclosure relied on from Heene fails to qualify as prior art.

Heene was file on June 10, 2004, after Applicant's filing date of October 8, 2003, but claims priority to provisional application 60/478,105 ("Heene Provisional") filed June 12, 2003. Thus, the subject matter of Heene disclosed in Heene Provisional in compliance with 35 U.S.C. § 112, first paragraph, receives the benefit of the earlier filing date and may qualify as prior art under 35 U.S.C. § 102(e). *See*, MPEP § 2136.03(II). In other words, the Examiner *may not* rely on any subject matter disclosed in Heene that was not disclosed in Heene Provisional.

The instant Office Action concedes that, "Landman and Shaw fail to specifically disclose proprietary information from a private database in the server-side system and including at least a portion of the proprietary and non-proprietary information in the creative" as recited in Applicant's independent claims 1, 9, 17-19, 26, 33-35, 43, and 51-52. *See*, Office Action, pages 6-7. Despite Applicant's explanations of the substantive deficiencies of Heene in Applicant's prior response, the Office Action maintains that the teachings of Heene cure the deficiencies of Landsman and Shaw. However, the teachings of Heene applied in the Office Action fail to find any support in Heene Provisional.

A detailed review of Heene Provisional reveals a brief and high level disclosure the concept of merging newspaper classified ads and internet ads. Thus, Heene Provisional only

provides 35 U.S.C. § 112, first paragraph, written description support for such methods and systems. Heene Provisional fails to disclose,

a periodical publisher creating e-commerce enabled online classified advertisements based on print classified counterparts and other information *stored in multiple databases associated with the one or more Web servers. One of the databases used in an associated print classified ad database containing ad data used printed advertisements.(print classified counterparts) This data is proprietary to the publisher and the data is private to the publisher.* Furthermore, and online classified ad is created that includes using the printed classified ad *stored in the print classified ad database and advertisement data (other information) from an ad placement software database wherein an online ad data formatting module receives ad data, process the data by formatting the collected data into an online classified ad.*

as recited on page 7 of the instant Office Action. Indeed, Heene Provisional only discloses ads that originate at the ad taker software programs in use at periodicals. The ads are then transferred to the e-commerce application for online use. Even giving Heene Provisional a very generous reading, the disclosure of the single originating system for ads *cannot possibly disclose including both non-proprietary and proprietary* information from the server-side system.

Because the Heene Provisional fails to provide written description support for the portions of Heene relied on in the Office Action, even if these portions of Heene could be construed as the Examiner suggests, Heene cannot be relied upon as prior art in rejecting Applicant's claims. Thus, because the Office Action concedes that Landsman and Shaw, alone and in combination, fail to render obvious Applicant's claims, Applicant respectfully requests reconsideration and removal of the rejection of claims 1, 2, 5, 9-10, 13, 17-20, 22, 26-27, 29, 33-36, 39, 43-44, 47, and 51-64 under 35 U.S.C. § 103(a).

Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman in view of Shaw, in further view of Heene, and in further view of Galomb (U.S. 2001/0039510). Applicant respectfully requests reconsideration and removal of this rejection for at least the reason that these claims depend from allowable base claims and Galomb fails to cure the above-recited deficiencies of the other cited prior art references.

Claim Amendments

Applicant amends independent claims 1, 9, 17-19, 26, 33-35, 43, and 51-52 herein to fix minor punctuation-related anomalies. These amendments are formal in nature and add no new matter. Applicant also amends claim 26 to correct the spelling of “definition”, claim 33 to delete the clause “for a viewer”, and claim 43 to correct the spelling of “on” to clarify the meaning of the claims. These amendments add no new matter. Applicant respectfully requests entry of these amendments after final because they only require cursory review and place the claims in better position for appeal.

Conclusion

In view of the foregoing, Applicant respectfully submits that the present application is in condition for allowance and notice to that effect is respectfully requested. If, however, the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney/agent to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. § 1.16 and 1.17, which may be required, including any required extension of time fees, or credit any overpayment, to Deposit Account No. 50-1529. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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